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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,872	11/07/2005	Christoph Kurth	MERTE.Y3-17	2384
28752 7590 09/07/2007 LACKENBACH SIEGEL, LLP LACKENBACH SIEGEL BUILDING 1 CHASE ROAD SCARSDALE, NY 10583			EXAMINER SNOW, BRUCE EDWARD	
			ART UNIT 3738	PAPER NUMBER
			MAIL DATE 09/07/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/516,872

Applicant(s)

KURTH, CHRISTOPH

Examiner

Bruce E. Snow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 6/18/07 have been fully considered. Priority has been noted on PTOL 326. Regarding the Surerus reference, said reference was made of record on applicant's search report as an "X" reference against all claims.

Regarding the rejection under the first paragraph of 35 U.S.C. 112, MPEP 714.02 states, "*Applicant should also specifically point out the support for any amendments made to the disclosure.*" It is the Examiner's position the claim language "ceramic composite" is broader than "threads of graphite" and is new matter. Regarding claim 22, the specification and drawings do not support what is being claimed. The electrically conductive region is clearly shown as element 5 in the distal end only.

Regarding the rejection under 35 U.S.C. 101, applicant is correct, there is nothing preventing claiming of non-body elements, the problem is when applicant positively claims parts of the body, thus claiming a human. As claimed, "bounding at least a portion of said stump" and "not in direct contact with said distal end of said stump" is not interpreted as mere functional language, but is interpreted as positively claiming non-statutory subjection matter.

Regarding the rejection under 35 U.S.C. 102(b) as being anticipated by Surerus (DT 2329929), applicant's has already provided a copy of the translation in addition to the translation obtained by the Office. It is the Examiner position that conductive material is positioned for direct contact with the limb. However, claim 14 only requires the conductive material to be surrounding and not spaced from the limb by insulating

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material as in claims 15 and 29. Note that Surerus teaches using wires or a varnish inside coating with graphite as the conductive material.

Regarding the rejection under 35 U.S.C. 102(e) as being anticipated by Flick (6,861,570), applicant states, "*Flick '570 fails to appreciate and indicate the specific requirements for employing electrically insulating material adjacent the treatment location.. whereby the electrically conductive larger sleeve matrix is shielded from direct contact with the limb*". However, this is irrelevant because of applicant's use of the open transitional language "comprising" which can include additionally components such as an inner conductive layer that would contact the limb when worn. As stated in the rejection, "Note that Flick teaches, in at least claim 1, teaches alternating conductive layers and non-conductive layers." Inherently a second or third conductive layer is not in direct contact with the limb and is being relied upon for the rejections of at least claim 15.

Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note Klasson (WO 88/00032) teaching embedded wires 4.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 17 and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant has added at least claims 17 and 22 and has failed to indicate where in the originally filed application support for each claim can be found. For example, claim 17, where can support for a ceramic composite be found? Claim 22, where can the non-distal-end be found? Applicant is required to indicate where support for each claim can be found. See MPEP 714.02.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 15-29 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter positively claiming a stump.

Regarding claim 15, "conductive layer bounding at least a portion of said stump" positively claims said stump.

Regarding claim 29, "bounding at least a portion of said stump" and "not in direct contact with said distal end of said stump" positively claim a stump.

Claim Rejections - 35 USC § 102

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim 14 is rejected under 35 U.S.C. 102(b) as being anticipated by Surerus (DT 2329929).

Surerus teaches a supporting member for limb stumps, namely a liner, comprising:

a sleeve member 7 further comprising at least an elastomeric material ("soft expanded plastic material);

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said elastomeric material being elastic and electrically insulating;

said sleeve member defining a cavity for receiving a distal end of a stump;

portions of said elastomeric material bounding said cavity for receiving

said stump;

said sleeve member further comprising a surrounding layer (Note that Surerus teaches using wires or a varnish inside coating with graphite as the conductive material);

and said surrounding layer composed of a conductive material.

Claims 14-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Flick (6,861,570).

Flick teaches a supporting member for limb stumps, namely a liner, comprising:

a sleeve member (see 20:59 et seq. teaching of liners for braces, tube sleeve, external body coverings) further comprising at least an elastomeric material;

said elastomeric material (see at least 17:37 et seq.) being (inherently) elastic and electrically insulating;

said sleeve member defining a cavity for receiving a distal end of a stump;

portions of said elastomeric material bounding said cavity for receiving

said stump;

said sleeve member further comprising a surrounding layer;

and said surrounding layer composed of a conductive material (see at least 17:41 et seq.) Note that Flick teaches any number of alternating electrically insulating layers and conducting layers.

Note that Flick teaches, in at least claim 1, teaches alternating conductive layers and non-conductive layers.

Regarding claim 2, the tubular embodiment shown in figure 45 is interpreted as defining a concave shape.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce E. Snow whose telephone number is (571) 272-4759. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to be 'Bruce Snow', with a long horizontal line extending to the right.

BRUCE SNOW
PRIMARY EXAMINER